Decision for dispute CAC-UDRP-100492

Case number	CAC-UDRP-100492
Time of filing	2013-05-14 13:13:26
Domain names	PIRELLI.INFO

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Pirelli & C. S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Name	Claudio Russo

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name

IDENTIFICATION OF RIGHTS

Community Trade Mark no. 9483173 "Pirelli" (word mark), filed on 29/10/2010, registered on 12/5/2011 for multiple goods in services in classes 1-45

FACTUAL BACKGROUND

As far as relevant for the decision the Complainant asserts the following:

The Complainant is a well-known multinational company based in Milan, Italy, which was founded in 1872.

Thanks to the success and leader position achieved by the Complainant in relation with all segments in which it operates, Pirelli’s marks are well-known worldwide.

The Complainant asserts to be the owner of numerous registrations and/or applications for trademarks, comprising the keyword “PIRELLI”.

The Complainant owns and actively uses the domain name “pirelli.com”, created on January 11, 1995, as its primary domain name, as well as numerous domain names.

The domain name “pirelli.info” ("the Domain Name") was registered on December 29, 2012, i.e. well after PIRELLI Marks. As certified by the printout of the relevant WHOIS records at the time of filing of the Complaint, Claudio Russo is shown as registrant.

The Domain Name should be transferred to the Complainant, because it constitutes usurpation and violation of the rights of the Complainant with regard to its trademarks registered in Italy and worldwide, its domain names and company name for the following reasons:

The Domain name is identical and/or confusingly similar to Complainant’s trademarks, company name and domain names, because it wholly incorporates the dominant component of PIRELLI Marks, namely the wording “PIRELLI”.

It is well founded that the disputed domain name is to be considered identical and/or confusingly similar to PIRELLI Marks since the top-level suffix “.info” is to be ignored for the purpose of determination of the similarity between the disputed domain name and the word “PIRELLI” (as it is a technical requirement of registration). See WIPO/D2002-0760 (barep.biz inter alia); WIPO/D2002-0424 (geac.org).

It is undoubtful that the suffix “.info” does not affect the attractive power of the dominant part of PIRELLI Marks, i.e., “PIRELLI”, and the domain name “pirelli.info” is consequently identical and/or confusingly similar to the Complainant’s marks.

The domain name “pirelli.info” can be confused with:

The identity and/or similarity of the disputed domain name to PIRELLI Marks, is likely to lead to confusion and/or association for the Internet users.

The Complainant shall make a prima facie showing that the Respondent has no rights and interests in the domain name; however, the burden of proof with respect to this element is light for the Complainant. See WIPO/DTV2002-0005 (deagostini.tv); WIPO/D2000-0648 (pivotalsoftware.com); WIPO/D2002-0503 (arroyocraftsman.com); WIPO/D2003-0455 (croatiaairlines.com).

Pirelli has no relationship with the Respondent whatsoever. Pirelli has never authorized the Respondent to use the domain name “pirelli.info” or any other domain name. Additionally, there is no indication that the Respondent has any legitimate interest in PIRELLI Marks according the searches done on the web sites of the Italian Patent and Trademark Office (UIBM), the EU’s Office of Harmonization for the Internal Market (OHIM), WIPO, the United States Patent and Trademark Office (USPTO).

Further, entering “pirelli.info” in the address bar of an internet browser resolves to a web site containing third parties´ links to further web site (“sponsored listings”). Furthermore, on such web site an inquiry form can be found, from which it is clear that the domain name “pirelli.info” is for sale.

Hence, there is no evidence that the Respondent, before any notice of the dispute, used or prepared to use the domain name “pirelli.info” in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use, without intent for commercial gain. Finally, there is no evidence that the Respondent has been commonly known by the domain name “pirelli.info”.
See decisions: NAF/FA190644 (nicklausgolf.com - “Respondent’s use of a domain name confusingly similar to Complainant’s mark(s) to divert Internet users to websites unrelated to Complainant’s business does not represent a bonafide offering of goods or services under Policy 4(c)(i) or a legitimate noncommercial or fair use under Policy 4(c)(iii)”); NAF/FA93554 (bigdog.com – finding no legitimate use when respondent was diverting consumers to its own web site by using complainant’s trademark(s)); WIPO/D2000-1204 (msnbc.org – finding no rights or legitimate interest in the famous

MSNBC mark where respondent attempted to profit using complainant's mark by redirecting Internet traffic to its own website); NAF/FA96356 (broadcom2000.com - finding no rights or legitimate interests because the respondent is not commonly known by the disputed domain name or using the domain name in connection with a legitimate or fair use); NAF/FA96209 (galluppll.com - finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); NAF/FA740335 (cigaraficionada.com - finding that the respondent was not commonly known by the "cigaraficionada.com" domain name); NAF/FA881234 (stlawu.com - concluding that the respondent has no rights or legitimate interests in a disputed domain name where there is no evidence in the record indicating that the respondent is commonly known by the disputed domain name); WIPO/D2000-0020 (saint-gobain.net – finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name); WIPO/D2000-0403 (charlesjourdan.com – finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's registration; (3) the respondent is not commonly known by the domain name in question).

The disputed domain name has been registered and is being used in bad faith considering the following cumulative circumstances.

Respondent's bad faith is clearly evident from the fact that he has registered and/or has been using a domain name which wholly comprises the dominant component of well-known PIRELLI Marks ("PIRELLI") and, therefore, is confusingly similar to such PIRELLI Marks. This evidences a clear intent to trade upon the reputation and good will associated with PIRELLI Marks. Respondent has been deliberately using the domain name confusingly similar to PIRELLI Marks to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with PIRELLI's marks and products to the source, sponsorship, affiliation or endorsement of its domain name or of a product or service on such web site. Taking into account the vast and widespread advertising campaigns carried out by Pirelli for the promotion of products and services covered by PIRELLI Marks, it is unlikely that the registration of the domain name in question may be attributed to mere chance and not, as is, with a full awareness and intent to exploit the reputation and good will of the Complainant and PIRELLI Marks. See decision CAC Case N. 05367 (Giorgio Armani s.p.a. v. Antares S.p.A., Germano Armani).

Furthermore, a review of the web site to which "pirelli.info" resolves makes it clear that the domain name has been registered and used with a view of commercial gain. The disputed domain name resolves to a web site containing third parties´ links to further web site ("sponsored listings"). Moreover, on such web site an inquiry form can be found, from which it is clear that the domain name "pirelli.info" is for sale.

Such circumstance is also confirmed by the correspondence between the Complainant and the disputed domain name's domain manager, Mr. Yuming Shanghao, showing the interest of the Respondent to sell the disputed domain name for valuable consideration in excess of the out-of-pocket costs directly related to the domain name.

In the light of the foregoing, it is more than likely that the registration of the domain name "pirelli.info" has been carried out with the sole purpose of exploiting Pirelli's reputation and good will for commercial gain.
See decisions of the Czech Arbitration Court: Case N. 04316 (Prada SA v. Maurizio Lussetti); Case N. 05650 (Salumificio Fratelli Beretta S.p.A. v. Nico Maria Cavallo), Case N. 05572 (KG Industries LLC v. KG Industries, Gary Powell KG Industries); Case N. 05572 (Zott GmbH & Co. KG v. Victor Somov).
See also NAF/FA95464 (statefarmnews.com – finding that respondent registered the domain name "statefarmnew.com" in bad faith because that respondent intended to use a complainant's marks to attract the public to the web site without the permission from that complainant); NAF/FA123933 (celebrex-drugstore.com – finding that respondent registered and used the domain name in bad faith pursuant to ICANN Policy 4(b)(iv) because respondent was using the confusingly similar domain to attract Internet users to its commercial website; NAF/FA126835 (barbiesgalleries.com – citing WIPO/D2000-1221 Pavillion Agency, Inc v. Greenhouse Agency Ltd finding that the "domain names are obviously connected with the complainant that use or registration by anyone other that complainant suggests "opportunistic bad faith""); NAF/FA96356 (broadcom2000.com); NAF/FA96209 (galluppll.com); NAF/FA740335 (cigaraficionada.com); NAF/FA881234 (stlawu.com).

PARTIES CONTENTIONS

The Respondent did not file a Response.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

[1]
The Panel concurs with the view that a respondent's default does not automatically result in a decision in favour of the complainant but that the complaint must build a case that the prerequisites for the requested transfer of the disputed domain name under the UDRP are fulfilled (c.f. e.g. CAC UDRP cases Nos. 100259 – ECCOSHOESSHOP.COM; 100004 – novotelvietnam.com; 100095 – leros-boatyard.com; 100093 - asia-airfrance.com and WIPO cases Nos. D2002-1064 – vanguar.com; D2003-0465 – berlitzsucks.com; D2004-0383 – brookhogan.com).

This includes that the complainant shows to the panel that he has rights in a relevant trademark or service mark within the meaning of paragraph 4(a)(i)of the Policy.

The Panel informed the Parties via Non-Standard Communication that it does not consider the "Trademark list" presented as ANNEX 3 as appropriate proof of such rights (cf. also obiter CAC UDRP case No. 100478 – LIQUIMOLY.NET et al. at [10]) and gave the Parties the opportunity to comment on this opinion of the Panel and the Complainant the opportunity the to produce respective evidence. The Complainant in the following submitted a number of trade mark registration certificates, amongst others the certificate of Community Trade Mark no. 9483173 "Pirelli" (word mark), filed on 29/10/2010, registered on 12/5/2011 for multiple goods in services in classes 1-45.

PRINCIPAL REASONS FOR THE DECISION

[2]
In order to succeed in its claim, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) UDRP have been satisfied: (i) The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and (ii) The Respondent has no rights or legitimate interests with respect to the Domain Name; and (iii) The Domain Name has been registered and is being used in bad faith.

[3]
The Complainant has provided sufficient evidence that he is the owner of the Community Trade Mark no. 9483173 "Pirelli" (word mark), filed on 29/10/2010, registered on 12/5/2011 for multiple goods in services in classes 1-45, as identified above. This trademark is confusingly similar to the Domain Name as required by Paragraph 4(a)(i) UDRP.

In the view of the Panel it is the uncontested position under the UDRP that the top level domain, such as ".info" in the present case, has to be excluded while comparing the trade mark with the domain name (c.f. e.g. CAC UDRP cases nos. 100004 – novotelvietnam.com; 100084 – paiement-cic.com; 100074 – michelintires.info; 100093 - asia-airfrance.com; 100259 – ECCOSHOESSHOP.COM and WIPO cases nos. D2000-1532 – brucespringsteen.com; D2002-0234 – herballife.net and DCC2003-0001 – officemax.cc).

The second level domain of the Domain Name is, however, identical to the trade mark in question. Consequently, the Panel finds that the domain name and the Complainant's trademark are identical.

[4]
In the view of the Panel the Respondent does not have rights or legitimate interests in respect of the Domain Name according to Paragraph 4(a)(ii) UDRP. Although the onus of proof for this second requirement under the UDRP rests with the Complainant, the Panel follows the view that it is impossible for a complainant to prove a “negative fact”, which would require information that is primarily within the knowledge of the respondent. Therefore, a complainant is required to make out a prima-facie case that the respondent lacks rights or legitimate interests and the onus of proof then shifts to the respondent to rebuke the complainant’s prima-facie case (c.f. e.g. CAC UDRP cases Nos. 100053 – enterprisecarrentalonline.info; 100084 – paiement-cic.com; 100092 – lerosmarina.com; 100099 – sublimedirections.com; 100093 - asia-airfrance.com; 100259 – ECCOSHOESSHOP.COM and WIPO cases Nos. D2003-0455 – croatiaairlines.com; D2004-0110 – belupo.com).

The Complaint has made out such a prima-facie case and stated, amongst others, that the Complainant is not aware of the fact that the Respondent is known by the term “Pirelli” and that the Complainant has not licensed the right in the use of this designation to the Respondent. Paragraph 4(c)(iii) UDRP states that a use under legitimate interests would require that the Respondent makes a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue. Since the Respondent's website under the Domain Name, according to the undisputed assertions of the Complainant, shows sponsored listings and a form through which the Domain Name can be acquired, there is in the opinion of the Panel no noncommercial or fair use of the Domain Name.

[5]
The Panel is, furthermore, of the opinion that the Domain Name has been registered and is being used in bad faith according to Paragraph 4(a)(iii) UDRP. As Paragraph 4(b) UDRP clearly states: for the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
[...]
(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; [...].

This is the case here, since the Respondent, as shown in ANNEX 13 and undisputed by the Respondent, offered to sell the Domain Name initially for 1.690 EUR and hence for more than his out of pocket costs.

[6]
Since all three requirements under Paragraph 4(a) UDRP have been proven by the Complaint to the satisfaction of the Panel, the Complainant is entitled to a transfer of the Domain Name as requested in the Complaint.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **PIRELLI.INFO**: Transferred

PANELLISTS

Name	**Dr. Uli Foerstl, LL.M.**

DATE OF PANEL DECISION 2013-07-02

Publish the Decision